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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,539	07/16/2003	Manfred Ostertag	14066-024001 / 2003P00076	8440
32864	7590	01/19/2006	EXAMINER	
FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			LIN, WEN TAI	
		ART UNIT	PAPER NUMBER	
		2154		

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/620,539	OSTERTAG ET AL.
	<b>Examiner</b> Wen-Tai Lin	<b>Art Unit</b> 2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 November 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-75 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/15/05.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Claims 1-75 are presented for examination. Claims 76-111 have been withdrawn and claims 1-75 have been amended.
2. Objection to claims 5, 18, 31, 44, 56 and 68 is withdrawn because Applicant's remarks filed on 11/21/2005 clarified that the term "enterprise resource planning system" does not necessarily imply any planning system. For purpose of prior art rejection in this office action, this term is being construed as any resource arrangement system/program a company might have for running its business.
3. The amendment filed 11/21/2005 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. Specifically, claims 1, 14, 27, 40, 52 and 64 introduce a new limitation requiring that the data source from which a search is performed must be "other than profiles associated with a defined recipient list". It appears that Applicant attempts to exclude profile-related database from the aforementioned mentioned data sources without revealing the definition of the word "profile" and/or distinctly showing how a company's employee database (upon which Applicant solely relies) is not a collection of employee profiles. Note that the ambiguity is not about the "defined recipient list" because each employee database also has a

defined recipient list containing all the employees listed in the database; it is rather due to the addition of the word “profile” (which has not been used in the specification) in the claim language that leads to indefiniteness in the scope of the claims. (See also 608.01(o) “Basis for Claim Terminology in Description”).

Applicant is required to cancel the new matter in the reply to this Office action. Further, for purpose of prior art rejection in this office action, the word profile is being ignored from claims 1, 14, 27, 40, 52 and 64.

4. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.

***Claim Rejections - 35 USC § 102***

5. Claims 1-75 are rejected under 35 U.S.C. 102(e) as being anticipated by Olivier [U.S. Pat. No. 6480885].

6. Olivier was cited in the last office action.

7. As to claim 1, Olivier teaches the invention as claimed including: a method of mining human capital information, the method comprising:

receiving user input specifying criteria of association with a dynamic target group by defining one or more attributes of a communication group[e.g., 202, 250, 254, Fig.2];

identifying individuals of the dynamic target group by searching one or both of explicit and implicit data sources according to the defined attributes, wherein a scope of the search performed includes at least one data source other than associated with a defined recipient list [col.6, lines 34-53; 258, 234, Fig.2];

communicating with identified individuals of the dynamic target group [e.g., 238, Fig.2];

logging at least some of the communications; and analyzing the logged communications [col.3, lines 23-32 and 57-60; Abstract, lines 15-17].

8. As to claim 2, Olivier further teaches saving the defined attributes [i.e., the attributes forming each group must be saved otherwise the match servers of Fig.7 would not know what to match].

9. As to claim 3, Olivier further teaches communicating with the identified individuals of the dynamic target group includes sending to the identified individuals of the dynamic target group an information request based on at least one of a survey and a questionnaire [e.g., in response to an email of Figs. 8-9].

10. As to claim 4, Olivier further teaches generating a report based on a result of analyzing the logged communications [e.g., col.3, lines 57-60; i.e., report on each subject as individualized archive].

11. As to claim 5, Olivier further teaches accessing an enterprise planning system to identify individuals of the dynamic target group [e.g., Figs. 2 and 3B, wherein Fig.2 illustrates a planning system that is carried out by a system resource of Fig.3B; see also the interpretation of the term “enterprise resource planning system” in paragraph 2 of this office action].

12. As to claim 6, Olivier further teaches sending information to a member of the dynamic target group triggered on an occurrence of a life or work event associated with a member [see the example of Fig.8].

13. As to claim 7, Olivier further teaches defining attributes includes defining attributes based on at least one of special knowledge area, work experience, academic experience, position, and work situation associated with the dynamic target group [col.17, lines 7-14; col.18, lines 5-17].

14. As to claim 8, Olivier further teaches communicating occurs over at least one of a computer network, wireless, the Internet, an Intranet, electronic-mail and voice-mail [Abstract].

15. As to claim 9, Olivier further teaches communicating includes sending to the identified individuals of the dynamic target group at least one of structured communication [e.g., 524 of Fig.9 is structured communication] wherein possible

responses to queries are predefined and unstructured communication wherein possible responses to queries are not predefined [i.e., by default reply to question at 526 of Fig.9 (after satisfying matching criteria) is unstructured and not predefined].

16. As to claim 10, Olivier further teaches that communicating includes distributing information to the identified individuals of the dynamic target group, and receiving feedback from the identified individuals of the dynamic target group [Abstract].

17. As to claim 11, Olivier further teaches providing an enterprise with an ability to make decisions based on a result of analyzing the one or more logged communications [col.3, lines 57-60; col.17, lines 21-27; i.e., filtering uncorrelated material (including spasm) is a decision making process based on what's in the archive].

18. As to claim 12, Olivier further teaches that searching explicit data sources includes searching data sources having explicitly defined attribute information [e.g., col.9, lines 18-29; i.e., explicit data is entered as a user's profile through registration].

19. As to claim 13, Olivier further teaches that searching implicit data sources includes searching data sources having implicitly defined attribute information [e.g., col.16, lines 56-66; i.e., attributes specified in an email requiring additional processing are thus indirectly obtained].

20. As to claims 14-18, 19-31, 32-40, 44, 56 and 68, since the features of these claims can also be found in claims 1-5 and 6-13, they are rejected for the same reasons set forth in the rejection of claims 1-5 and 6-13 above.

21. As to claim 41-42, Olivier further teaches generating and updating a distribution list of the target group at the time information is exchanged with the target group [e.g., col.25, lines 1-11; col.23, lines 26-50; i.e., in a chat or game setting, updating the list is inherently required because members come and go]

22. As to claims 43, 45-55, 57-67 and 69-75, since the features of these claims can also be found in claims 14, 21, 23, 25-27, 29, 32-33, 35-36, 38-40 and 42, they are rejected for the same reasons set forth in the rejection of claims 14, 21, 23, 25-27, 29, 32-33, 35-36, 38-40 and 42 above.

23. Applicant's arguments filed on 11/21/2005 for claims 1-75 have been fully considered but they are not deemed to be persuasive.

Specifically, Applicant argues in the remarks that Olivier's teaching is limited to searching subscribers of a mailing list, which is a defined recipient list, while Applicant's system allows searches to include profiles of users who have not subscribed to any mailing lists.

24. The examiner respectfully disagrees with Applicant's remarks. In accordance with at least one embodiment [see, e.g., 202, 250, 254, 258, 234 and 238 of Fig. 2], Olivier's formation of a dynamic target group (or message recipients) is obtained by performing a database search, wherein the database is formed by collecting all subscribers' profiles [444, Fig.5A] and the database constitutes the implicit or explicit data sources in the claim language. For at least the above reasons, it is submitted that the prior art of record reads on the claims.

25. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

26. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

**Examiner note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

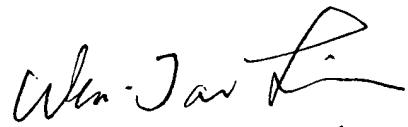
(703)872-9306 for official communications; and

(571)273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

January 16, 2006

  
1/16/06